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**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 22

Application Number: 09/372,750  
Filing Date: August 11, 1999  
Appellant(s): BROWN ET AL.

\_\_\_\_\_  
D. Richard Anderson

\_\_\_\_\_  
For Appellant

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 27 February 2004.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

Appellant's brief includes a statement that all claims do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

**(8) Claims Appealed**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) Prior Art of Record**

5974401	Enamoto et al.	10-1999
6017157	Garfinkle et al.	01-2000

**Appendix A:**

**Barron's Dictionary of Business Terms**

**Barron's Dictionary of Finance and Investment Terms**

**Computer Desktop Encyclopedia**

**MICROSOFT Computer Dictionary**

**Random House Computer and Internet Dictionary**

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 2-3, 5-9, 11-18, 20-35 and 37-60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Enamoto (US 5,974,401) in view of Garfinkle (6,017,157).

As a preliminary matter, please note the following word processing errors in

Appellant's Brief:

- Page 14, last four lines, reads, "The user fails to provide any motivation..." This should read, "The **Examiner** fails to provide any motivation..."
- Table of Contents, page ii, states, "...L. The Rejection fails to Establish Prima Facie Obviousness of Dependent claims 11-18, 37-40, 48 and 53-54." This should read, "...L. The Rejection fails to Establish Prima Facie Obviousness of Dependent claims 11-18, **38-40**, 48 and 53-54." This error also appears on page 25 of Appellant's brief.

**(11) Response to Arguments**

**A**, Argument Summary/Enamoto, page 8, and **B**, Legal Requirements of Prima Facie Obviousness, page 9.

The Examiner has consolidated related arguments, which are spread out in pages 10-27 of Appellant's brief. The Examiner respectfully notes that these remarks do not constitute new grounds for rejection, but merely serve to expound upon the previous rejection.

Appellant comments appear to be general allegations patentability and as such they fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references. Examples:

As the Examiner has failed to provide a reference that teaches or suggests...

- [recitation of claim limitation]
- ...it is respectfully submitted that the Examiner has failed to establish prima facie obviousness under 35 U.S.C. 103(a).
- [Appellant's conclusion, one or more of of:]
  - Thus, claim [##] is patentable over [references].
  - As such, the Examiner has failed to provide a reference that teaches or suggests all of the claim elements, thus failing to establish prima facie obviousness.
  - For the reasons set forth above, claim [##] is patentable over [references].
  - Claim [##] is patentable over the references **as cited** by the Examiner.

In some instances, there are no arguments in support of separate patentability.

**Appellant argues that the Examiner has failed to provide references that teach or suggest various claim limitations.**

In response to this argument, Examiner once again notes that Enamoto and Garfinkle are used to show online ordering services for image related services and products. The Examiner provided a number of definitions and references to support his arguments concerning teachings, suggestions and motivations either in the references

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themselves *or in the knowledge generally available to one of ordinary skill* in the art.

Copies of the above are provided in an Appendix to the Examiner's Answer.

Appellant has not argued or shown, for example, that one of ordinary skill in the art would not be aware of the following references, or that the definitions in these references are invalid. Among them:

- *Barron's Dictionary of Business Terms* for a definition of Buy, Sale.
- *Barron's Dictionary of Finance and Investment Terms* for a definition of (an) Order.
- *Black's Law Dictionary* for a definition of Traverse.
- *Computer Desktop Encyclopedia*, for a definition of Personal Computer, Library, File.
- *MICROSOFT Computer Dictionary* for a definition of Windows, E-commerce, Interface, Access, Pointer, URL.
- *Random House Computer and Internet Dictionary* for a definition of application, Download.

Therefore, Appellant's arguments that the Examiner has failed to provide references that teach or suggest various claim limitations are not persuasive.

**Appellant argues that Examiner's Interpretation of shell extension is too broad**

Prior Art is interpreted to read on appellant's (a) *shell extension to (b) an operating system desktop shell interface* where prior art discloses or suggests (a) a **button** (or similar) on (b) a **browser** (or other user interface, e.g., for accessing files, or accessing other services). Clicking on a button may execute one or more sets of computer-readable instructions. Please note that the Examiner's interpretation of ... *operating system desktop shell interface...* and ...*shell extension...* has not been shown to be incorrect, and has not been adequately and timely traversed.

Appellant also argues:

...in interpreting the claim language, the Examiner's interpretation of the term "shell extension" to be any interface is too broad...

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...[Enamoto's] software is installed on the personal-computer and operates **on top** of the operating platform of the system. There is no teaching or suggestion in Enamoto that this application be provided in a shell extension. Brief, Page 12.

...a graphical user interface is not **equivalent** to a shell extension. A graphical user interface is a software application that operates **on top** of an operating platform. In contrast, a shell extension operates **within** the operating platform. Brief, Page 13.

...Further, it is not well known to use shells or shell extensions to facilitate print ordering. Brief, Page 15.

...It is respectfully submitted that a browser is a **software application** whereby a user may access the Internet. One of ordinary skill in the art would appreciate that a browser is not an extension to a shell interface. In fact, as noted above, claim 30 recites that the extension to the operating system desktop shell interface permits a user to initiate an order directly from a system file level of the operating system, without invoking an additional application program. Brief, Page 18.

Appellant also argues that a shell extension as "*...a small system utility...*"

...it is true that a shell extension is an interface, [but] not all interfaces are shell extensions. One of ordinary skill in the art would interpret a shell extension as a **small system utility** that allows a user to access and configure the computer's operations. Brief, Page 11.

Appellant's new definition is introduced in his request for reconsideration after the final rejection and in the Appeal Brief. The new definition does not place the claims in better conditions for appeal and allowance.

Appellant concludes that

...It would not be obvious to incorporate a shell extension to supply third image data to the user [sic] extension where the shell extension is capable of facilitating an order as set forth in claim 28. Brief, page 12, emphasis added.

...appellants admit that shell extensions are known within the context of an operating system, it is respectfully submitted that the use of shell extensions to facilitate the ordering of photo print related services in a network photo print system is not well known. Brief, page 12.

Further in response to Appellant's arguments, each pending claim is interpreted as broadly as their terms reasonably allow, consistent with the interpretation that would be reached by one of ordinary skill in the art and in light of and consistent with the written description. In this case, (1) appellant provided no definition, and (2) Appellant

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use refers to *computer-readable instructions by using* generic labels and terms synonymously. These terms do not provide patentable moment.

(1) **Appellant provided no definition of ...*shell extension to an operating system desktop shell interface...* also known as *shell extension*.** In the absence of a definition, the Examiner relied on Appellant's Fig. 5 shows a MICROSOFT Explorer graphical user interface that accesses a file system (Appellant's operating system desktop shell interface). Fig. 5 also shows a button that reads "*Print at Fuji*". This button corresponds executes computer-readable instructions (Appellant's *shell extension to the operating system desktop shell interface*). The following appears in Appellant's Specifications, page 8, lines 11-32, emphasis added:

...The NAP module 216 also transfers digital images stored in the file system 212, using a shell extension 219 to the operating system. ***The shell extension 219 permits a technique for providing a PRINT option on a PROPERTIES menu, available through a 1 right mouse button click on a file.*** The shell extension 219 thus extends the operating interface, such that an option appears for image file icons on the PROPERTY menu and/or the FILE menu, such that consumers can print their photos without having to invoke a separate application program. Specification as filed, page 4, lines 3-17, as amended, emphasis added.

In order to start the above described transfer, the consumer 1 opens the "My Computer" window or Windows Explorer, right clicks on any image file to bring up the properties menu, and selects the ***print*** option, as illustrated in ***Figure 5***. The consumer 1 right clicks on one or more image files and chooses the ***print*** option, and the operating system launches the shell extension 219. The shell extension 219 creates JPEG thumbnail images and displays all the images. The consumer 1 selects the correct pictures to be uploaded. The consumer 1 clicks the ***print button*** as illustrated in ***Figure 5***. The shell extension 219 then calls the NAP module 216 and transfers pointers to the thumbnail image files and the current resolution of each thumbnail.

Clicking on the ***button*** executes computer-readable instructions:

The NAP module 216 calls the network sales server 220, identifies itself, and passes the pointers to the thumbnail images and the current resolution to the network sales server 220. The network sales server 220 requests the consumer to provide a shipping/billing address and billing information. When the consumer 1 "checks out", the network sales server 220 calls back to the NAP module 216 passing a job number and asking for all the



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pictures the consumer 1 placed orders and necessary resolution needed to fill the order. The shell extension 219 bundles into a ZIP file all the files requested at their maximum resolution in JPEG format, plus other information saved to the specified directory, and passes it to the NAP module 216. The NAP module 216 uploads the file to the network sales server 220. The network sales server 220, the order processing server 222, the photo finishing lab 230 and/or the third party fulfillment house 240 process the order and the consumer 1 receives the desired photographs and/or merchandise via other means. The network sales server 220 also sends a confirmation to the consumer 1.

The Examiner's analogy is supported by appellant's comments concerning Williams (Brief, pages 11-12). Appellant relies on Williams to describe various shell extension types for an operating system such as MICROSOFT's WINDOWS NT. Williams appears to corroborate the Examiner's interpretation of a shell extension, since appellant's shell extension would fall under the category of context menu extensions. Appellant's Fig. 5 appears to present a MICROSOFT operating system EXPLORER file interface.

**(2) Appellant refers to *computer-readable instructions by using* generic labels and terms synonymously. These terms do not provide patentable moment.**

Appellant uses the various the terms without regard to whether the claims refer to a system (claim 28), a computer program (claim 37), a method (claim 32) and a computer signal (claim 41). There is no adherence to technical definitions of terms. Appellant's new definition is contrary to his generic terms. The labels are not functionally related to the substrate. The labels include: program, application program, software, module, shell extension, code segment, segment, computer program, among others. For example:

Claim 28 and dependent claims, drawn to a **system**. Appellant labels the executable computer-readable instructions "camera/scanner applications program" "photo editing applications program", "operating system", and a "network access protocol module".

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- Claims 29 and 31 refer to executable computer-readable instructions as *network access protocol module*.
- Claim 30 refers to executable computer-readable instructions as *extension to the operating system desktop shell interface*.

Claim 37 and dependent claims, drawn to a **computer program**, also refer to applications, code segments, including a network connection code segment, an ordering code segment, a receiving code segment, and an updating code segment. Specifically:

- Claims 12 and 18 refer to a **computer program** that has a photo editing application, a digital device interface application and a third application that appellants refer to as "...shell extension..." Thus, appellant categorizes "...shell extension..." as one of three applications, all of which are part of a computer program.
- Claim 15 refers to an image-related service.
- Claim 16 states that the computer program has an uploading code segment.
- Claim 17 refers to a checking code segment.
- Claim 39 refers to a display code segment.
- Claim 40 refers to a thumbnail image transmitting code segment.
- Claim 53 refers to a code segment for establishing a network connection, an initiating code segment for initiating an application at a network access protocol module.
- Claim 18 also refers to an external network entity (computer program).
- Claim 54 refers to a digital device interface applications program, a photo-editing applications program and a shell extension. Please note that claim 54's labels are also used in claim 28, which is directed to a system.

Claim 41 and dependent claims, drawn to a **computer signal**, refer to image-related services, a network connection segment, ordering segment, accessing an application, a receiving segment, an uploading segment.

- Claim 21 refers to a photo editing application, a digital device interface application and to a third application that appellant labels "...shell extension..."
- Claim 25 refers to an uploading segment,
- claim 26 refers to a checking segment,
- claim 27 refers to photo editing application, digital device interface application, a shell extension and external network entity.
- Claim 44 refers to a display segment.
- Claim 45 refers to a thumbnail image pointer transmitting segment.
- Claim 57 refers to a segment for establishing a network connection that has a segment for initiating an application at a network access protocol module though an shell extension [...to an operating system...].
- Claim 58 refers to a digital device interface applications program, a photo editing applications program and a shell extension.
- Claims 59 and 60 refer to a segment for exchanging ordering information that has a segment for providing information.

Claim 32 and dependent claims are drawn to a **method**.

- Claim 3 refers to a photo editing application, a digital device interface application and a shell extension. Claim 9 adds a external network entity.
- Claim 49 initiates an application at a network access protocol module though a shell extension [...to an operating system...]
- Claim 50 refers to a photo editing applications program, a digital device interface applications program and a shell extension.
- Claim 55 refers to a computer-readable program, a code segment for exchanging ordering information that has a code segment for providing at lest one pointer.

- Claim 56 also refers to a computer-readable program, a code segment for exchanging providing information [...related to...], image related services and a code segment for exchanging ordering information.

Therefore, Appellant's arguments that the Examiner's Interpretation of shell extension too broad and incorrect are not persuasive.

**C. Appellant argues, pages 10-15, that the rejection fails to establish a prima facie obviousness of Independent claim 28.**

The Examiner respectfully disagrees for reasons stated in the last office action. However, the Examiner will take this opportunity to further elaborate on the rejection and to further clarify the record, and so that appellant may more easily identify particular features of his invention that are unpatentable over prior art and knowledge generally available to those of ordinary skill in the art at the time of the invention. The Examiner respectfully again notes that these remarks do not constitute new grounds for rejection, but merely serve to expound upon the previous rejection. Claim 28 reads:

28. (Twice Amended) A network photo print system, comprising:
- (a) **a user station**, capable of running
    - (b) a camera/scanner applications program for supplying first image data to the user station,
    - (c) a photo editing applications program for supplying second image data to the user station,
    - (d) an operating system, including
      - an operating system desktop shell interface and
      - an extension to the operating system desktop shell interface, the shell extension supplying third image data to the user station, wherein the shell extension is capable of facilitating an order, and
    - (e) a network access protocol module capable of
      - receiving any one of the first, second, and third image data,
      - receiving order and merchandise availability information from an external network entity;
      - processing the order based on any one of the first, second, and third image data, and outputting any one the first, second, and third image data;
    - (f) **a network sales/order processing server** for receiving the order and for receiving any one the first, second, and third image data image data from the user station after receiving the order; and

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- (g) **a photofinishing lab** for producing photographic-quality prints images based on the order and any one the first, second, and third image data from the network sales/order processing server.

**The preamble of claim 28** reveals that appellant claims a system, which appellant labels “a network photo print system.” Enamoto and Garfinkle both disclose systems that accept and process orders for photographic images over networks.

Claim 28 requires a client that is **capable of** carrying out four functions by executing computer-readable instructions. Appellant labels the executable computer-readable instructions (a) a “camera/scanner applications program” (b) a “photo editing applications program”, (c) an “operating system”, and (c) a “network access protocol module”. Again, please note that the labels by themselves fail to provide patentable moment and are not functionally related to the substrate.

Appellant’s system contains various nodes, including (a) a node that appellant labels “user station” (i.e., Enamoto’s and Garfinkle’s clients in client/server network architecture), (b) a server that appellant labels “network/sales order processing server” and (c) a node that appellant labels “photofinishing lab”

**(a) a user station, capable of running...** Enamoto’s clients are capable of running at least the four types of computer-readable instructions claimed by Appellant:

**(a.1) digital device interface applications program** such as used for scanning images and for digital photography. See at least Col. 1, line 40-Col. 2, line 32 concerning the types of images that may be received and stored at a user station. The user station may run camera/ scanner application programs for supplying image data to a station (see at least Col. 1, line 40-Col. 2, line 32);

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**(a.2) photo-editing application program(s).** See at least Col. 3, lines 41-54.

Enamoto carries out different types of formatting and editing of digital images, including image correction, etc. Enamoto also discloses digital device interface applications in image processing programs and software. The programs perform different types of formatting and trimming, i.e., editing, of digital images, including image correction;

**(a.3) operating system.** Enamoto teaches the use of PC's/desktops. It is well known that a personal computer is a computer that serves one user; a personal computer may be used at home and in the office for almost all applications traditionally performed on large computers.<sup>1</sup> Personal computers have *operating systems*. Appellant has never argued or shown otherwise.

Enamoto, like Garfinkle, discloses libraries, directories, files and records. Users may access, copy, move, etc. these via buttons (shell extensions) to operating system desktop shell interfaces such as browsers.

**(a.3.1) an operating system desktop shell interface...** From the Final Office Action: Enamoto is also capable of running (executing computer-readable instructions) what appellant labels *operating system desktop shell interface*. As noted previously, some examples of operating system desktop shell interfaces include a browser, a graphical user interface to manage files. Enamoto does not use the term operating system desktop shell interface. As previously noted, Enamoto discloses PC/s and desktop computers.

An operating system is the master control program that runs a computer; Operating systems such as Macintosh, DOS, Windows are designed for one person at a *desktop computer*. Windows NT, LINUX and UNIX are network operating systems because they are designed to manage multiple user requests at the same time.<sup>2</sup> Operating systems may allow for different shells. For example, DOS, LINUX and UNIX support command-driven interfaces and can host other shells that provide a menu-driven or graphical interface.

Enamoto discusses the use of disks and that disks that may contain image data, including DVD (Digital Video Disc), FD (floppy disk), MO (magneto-optic) and CD (Compact Disc). See at least Col. 3, lines 21-30. See at least Col. 8, lines 27-33. These types of disks may contain image files. A file is a collection of bytes stored as an individual entity. All data on

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<sup>1</sup> Definition of Personal Computer. Computer Desktop Encyclopedia. American Management Association.

<sup>2</sup> Definition of Operating System. Id

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disk is stored as files with assigned file names that are unique within the directory where the file resides.<sup>3</sup> Enamoto discloses the use of libraries (see at least Col. 8, lines 33-41). A library is a collection of programs or data files.<sup>4</sup> Users may access files on various types of disks and libraries via file system interfaces (i.e., shells and shell extensions to operating systems). Different operating systems may use other file access interfaces. Windows (which is graphics-based to begin with) allows other shells to provide an interface to a user.<sup>5</sup>

Enamoto discusses the use of disks (see at least Col. 3, lines 21-30). Enamoto discloses other types of disks that may contain image data, including DVD (Digital Video Disc), FD (floppy disk), MO (magneto-optic) and CD (Compact Disc). See at least Col. 8, lines 27-33. These types of disks may contain image files...

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Enamoto and well-known file system interfaces (i.e., shell and shell extensions to operating systems) to permit users of personal desktop computers (i.e., applicants' user station) to access files on a personal desktop computer's disks, such as personal desktop computer's hard disk(s), floppy disk(s), DVD, FD, MO and CD.

One of ordinary skill in the art at the time the invention was made would have been *motivated* to combine Enamoto and well-known file system interfaces (i.e., shell and shell extensions to operating systems) and permit PC/desktop users to supply, *via user interfaces, digital image data by accessing files on a personal desktop computer's disks, such as personal desktop computer's hard disk(s), floppy disk(s), DVD, FD, MO and CD, for the obvious reason* that by including shells and shell extensions to *operating systems such as WINDOWS FILE EXPLORER*, users are provided with convenient, delightful, easy to use interfaces that allow them to manipulate file image data...(emphasis added)

Without such interfaces and extensions, users may feel overwhelmed or frustrated by having to enter obscure, non-intuitive operating system commands. Users who are unable to remember operating system commands may well avoid carrying on electronic commerce over the Internet, for example. On the other hand, well-designed, intuitive interfaces permit users to feel comfortable in performing complex operations such as moving a file from a local disk to a network drive. This creates a general feeling of satisfaction, delight and well being and permits users wide use of electronic commerce applications such as ordering customized products that contain images created by users.

**(a.3.2) an extension to the operating system desktop shell interface, the shell extension supplying third image data to the user station...**

By analogy, this limitation is met where prior art discloses or suggests the use of a **browser** (or other user interface, e.g., for accessing files, or accessing other services) and a **button** (or similar) on the browser. Clicking on a button may execute one or more sets of computer-readable instructions.

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<sup>3</sup> Definition of File. Id.

<sup>4</sup> Definition of Library. Id.

(a.3.2) wherein the shell extension is capable of facilitating an order...When claim 28 is read as a whole, "...wherein the shell extension is capable of facilitating an order..." merely describes inferential activities that are not involved in an active sense. As such, the descriptive material imparts little patentable moment in distinguishing the instant invention from that of the prior art. Enamoto and Garfinkle's clients are **capable of** executing computer-readable instructions that are capable of facilitating ordering and purchasing over networks. The descriptive material does not interact with media in any sense essential to establish patentability and does not fall into a safe harbor category. The Examiner found that the language carries very little patentable weight and expressly stated how the language was interpreted, consistent with MPEP 2106:

...When nonfunctional descriptive material is recorded on some computer-readable medium, it is not statutory since no requisite functionality is present to satisfy the practical application requirement. Merely claiming nonfunctional descriptive material stored in a computer-readable medium does not make it statutory. Such a result would exalt form over substance. *In re Sarkar*, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978) ("[E]ach invention must be evaluated as claimed; yet semantogenic considerations preclude a determination based solely on words appearing in the claims. **MPEP 2106, page 2100-12.**

- (a.4) **a network access protocol module** capable of
- receiving any one of the first, second, and third image data,
  - receiving order and merchandise availability information from an external network entity;
  - processing the order based on any one of the first, second, and third image data, and outputting any one the first, second, and third image data;
- (b) **a network sales/order processing server** for receiving the order and for receiving any one the first, second, and third image data image data from the user station after receiving the order; and
- (c) **a photofinishing lab** for producing photographic-quality prints images based on the order and any one the first, second, and third image data from the network sales/order processing server.

Although Appellant presents no arguments concerning items (a.4), (b) and (c).

Please refer to previous Office Actions.

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<sup>5</sup> Definition of Library. Id.

Please note that Enamoto and Garfinkle's clients are "...*capable of*..." executing computer-readable instructions that are "... *capable of* facilitating ordering and purchasing over networks..." Enamoto and Garfinkle do not limit their invention to any particular type or computer-readable instructions; they also do not limit their invention to particular labels that may be used. Appellant has not argued or shown that Enamoto and Garfinkle's are **not** "...*capable of* ..." executing computer-readable instructions, however labeled, and are **not** ...*capable of facilitating an order*...

For the above reasons, it is believed that the rejection of claim 28 under 35 U.S.C. § 103(a) for obviousness should be sustained.

**D. Appellant argues, page 15, that the rejection fails to establish a prima facie obviousness of Dependent claim 29.**

For response to arguments concerning claim 28, please see above.

For rejection of claim 29's limitation "...wherein said network access protocol module delays outputting a...[image data]...to...server until the order for a plurality of images is complete..." please refer to the Final Office, pages 8, 9, 17-18.

For the above reasons, it is believed that the rejection of claim 29 under 35 U.S.C. § 103(a) for obviousness should be sustained.

**E. Appellant argues, page 16, that the rejection fails to establish a prima facie obviousness of Dependent claim 30.**

For response to arguments concerning claim 28, please see above.



Appellant argues that the Examiner has failed to specifically address an element of claim 30, namely,

... wherein the extension to the operating system desktop shell interface permits a user of the user station to initiate an order directly from a system file level of the operating system, without invoking an additional application program.

In response to this argument, please refer to prior Office Actions, including paper # 5 of 23 January 2002, page 10 and Office Action # 9, of 8 July 2002, page 8.

Appellant has not adequately and timely traversed rejections of claim 30, which has never been amended.

Appellant also argues, without support, that a browser is a software application for carrying out certain functions, and that a browser is not an extension to a shell interface:

It is respectfully submitted that a browser is a software application whereby a user may access the Internet. One of ordinary skill in the art would appreciate that a browser is not an extension to a shell interface.

In response to these arguments, please note that Examiner's interpretation of a browser as equivalent to operating system desktop shell interface is not inconsistent with Appellant's use of the term browser in the specifications. As previously noted, Enamoto and Garfinkle are used to show online ordering services for image related services and products. Enamoto and Garfinkle do not mention invoking an additional application program to permit a user of a user station to initiate an order directly from a file interface, or for any function.

In addition, the recited statement of intended use, to "...permit a user station to initiate an order directly from a system file level of the operating system, without invoking an additional application program..." does not patentably distinguish the

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claimed system. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide any type of button on any type of interface for actions taught by Enamoto and Garfinkle because the subjective interpretation of the type of executable computer-readable instructions does not patentably distinguish the claimed invention.

For the above reasons, it is believed that the rejection of claim 30 under 35 U.S.C. § 103(a) for obviousness should be sustained.

**F. Appellant argues, page 18, that the rejection fails to establish a prima facie obviousness of Dependent claim 31.**

For response to arguments concerning claim 28, please see above.

For rejection of claim 31's limitation "...where a network access protocol module may be a plug-in module..." please refer to the Final Office, pages 16-17.

For the above reasons, it is believed that the rejection of claim 31 under 35 U.S.C. § 103(a) for obviousness should be sustained.

**G. Appellant argues, page 19, that the rejection fails to establish a prima facie obviousness of Dependent claim 46.**

For response to arguments concerning claim 28, please see above.

For rejection and response to arguments concerning claim 46, "...wherein the user station displays a locally stored thumbnail image corresponding to any one of the

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first, second, and third image data while sending ordering information to said network sales/order processing server..." please refer to Final Office Action, at least pp. 19-21.

For the above reasons, it is believed that the rejection of claim 46 under 35 U.S.C. § 103(a) for obviousness should be sustained.

**H. Appellant argues, page 20, that the rejection fails to establish a prima facie obviousness of Dependent claim 47.**

For response to arguments concerning claim 28, please see above.

For rejection and discussion of the limitation "...wherein said network access protocol module sends said network sales/order processing server a pointer to said thumbnail image locally stored at said user station..." please see at least Final Office Action, pages 19-21.

For the above reasons, it is believed that the rejection of claim 47 under 35 U.S.C. § 103(a) for obviousness should be sustained.

**I. Appellant argues, page 21-23, that the rejection fails to establish a prima facie obviousness of Independent claim 32, a method claim.**

Appellant argues that

...It is well known that the claims are to be interpreted in light of the specification. As such, Appellants are confused as to why the Examiner is looking to the references to find a definition as to what constitutes "all ordering information"...

In response to Appellant's arguments, the Examiner notes that although claims are interpreted in light of the specification, limitations from the specification are not read

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into the claims. The Examiner clearly communicated the basis for his interpretation of the claim language on Page 7 of the Final Office Action:

All ordering information

The Examiner respectfully notes that neither reference specifically defines what constitutes "all ordering information," per applicants' latest amendment. The Examiner respectfully submits that an order is a request to buy, sell, deliver or receive goods or services that commits the issuer of the order to the terms specified.<sup>6</sup> For purposes of this examination, Examiner will give the terms "order", "ordering," "ordering information", "all ordering information" their *broadest reasonable* interpretation to read on information sufficient to permit commercial activity to take place.<sup>7</sup>

Please note that Appellant introduced the term "...all ordering information..." in Amendment B, of 6 December 2003. The Examiner rejected the language as indefinite under 35 U.S.C. 112. In Amendment C, of 13 May 2003, Appellant responded that one of ordinary skill in the art can appreciate what other types of information would constitute ordering information, and referred the Examiner to his disclosures.

Appellant now argues that the Examiner ignored claim limitations.

...Further, it appears from the Examiners statements set forth above that the Examiner has removed the term "all" when providing support for the claim rejection....

...As the Examiner has failed to consider all of the claim elements, the Examiner has failed to establish prima facie obviousness by failing to provide references that teach or suggest all of the claim elements.

In response to these arguments, no claim limitations have been ignored. When examining the language as a whole, it is true that each of the limitations of a claim must be treated in the combination and relationships recited in order to make a prima facie case. Part of this treatment may be a determination that particular language does not limit the claim as a whole. The rejection follows the *Graham v. Deere* inquiries by determining the scope and content of the prior art, determining the differences between

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<sup>6</sup> Definition of Order, Barron's Dictionary of Finance and Investment Terms.

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the prior art and the claims at issue and resolving this difference in light of the level of ordinary skill in the art.

Enomoto and Garfinkle disclose E-commerce, i.e., commercial activity that takes place by means of computers connected through a network.<sup>8</sup> Both disclose methods, systems, networks, computer programs and signals for on-line *ordering, buying*<sup>9</sup> (cash, credit card, debit accounts) and *selling*<sup>10</sup> image-related goods and services for digital images:

The present invention relates to a method of *ordering and delivering* digital prints and a system therefor, which facilitates *ordering* digital prints and improves efficiency of printing and delivery of the digital prints at *low cost* without lowering print quality. (Enamoto, Col. 1, lines 6-10).

*Orders* for visual prints in various formats corresponding to the photographic image are then *received and fulfilled* from a fulfillment center... (Garfinkle, Col. 2, line 67-Col. 3, line 2).

The establishment which *fulfills, charges and delivers* the *order* will be referred to as the "fulfillment center." (Garfinkle, col. 3, lines 14-16).

"It will be understood that the HTML *interface* is utilized by the photographer 8 in the *sales* process to determine which of the digital images (if any) the photographer would like to *order* as a visual print.

...

When placing an *order*... (Garfinkle, Col. 7, lines 43-60).

In an alternate embodiment, an *order* form can be included with the index print, which the recipient can fill out and return to *place an order* 8d. (Garfinkle, Col. 8, lines 20-37).

For the above reasons, it is believed that the rejection of claim 32 under 35

U.S.C. § 103(a) for obviousness should be sustained.

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<sup>7</sup> The Examiner respectfully submits that this interpretation is not inconsistent with applicants' note that "...one of ordinary skill in the art can appreciate what other types of information would constitute ordering information." (Amendment C, page 9)

<sup>8</sup> Definition of e-commerce, MICROSOFT Computer Dictionary.

<sup>9</sup> To buy is to acquire property in return for money. Definition of Buy, Barron's Dictionary of Business Terms.

<sup>10</sup> A sale is any exchange of goods or services for money. Definition of Sale, Barron's Dictionary of Business Terms.

**J. Appellant argues, page 23, that the rejection fails to establish a Prima Facie case of obviousness of Dependent claims 2-3, 5-9, 33-35, 49, 50-52, and 55-56.**

For response to arguments concerning claim 32, please see above.

Appellant presents no arguments in support of separate patentability of claims 2-3, 5-9, 33-35, 49, 50-52, and 55-56

For the above reasons, it is believed that the rejection of claims 2-3, 5-9, 33-35, 49, 50-52, and 55-56 under 35 U.S.C. § 103(a) for obviousness should be sustained.

**K. Appellant argues, page 24, that the rejection fails to establish a prima facie obviousness of Independent claim 37.**

For response to Appellant's comments concerning claim 32, please see above.

Concerning claim 37, Appellant argues that Neither Enamoto nor Garfinkle teach or suggest "...uploading said digital image to said external network entity or another external network entity subsequent to exchanging all ordering information..."

In response to this argument, please see discussion of above as to what constitutes "...all ordering information..."

For the above reasons, it is believed that the rejection of claim 37 under 35 U.S.C. § 103(a) for obviousness should be sustained.

**L. Appellant argues, page 25, that the rejection fails to establish a prima facie obviousness of Dependent Claims 11-18, 37-40, 48, and 53-54.**

For response to arguments concerning claim 37, please see above.

Appellant presents no arguments in support of separate patentability of other claims.

For the above reasons, it is believed that the rejection of claims 11-18, 37-40, 48, and 53-54 under 35 U.S.C. § 103(a) for obviousness should be sustained.

**M. Appellant argues, page 26, that the rejection fails to establish a prima facie obviousness of Independent claim 41.**

Appellant argues that

Similar to the argument set forth above with regard to claim 32, neither [reference] teach or suggest uploading said digital image to said external network entity ...subsequent: to, exchanging **all ordering** information. As such, based upon the Examiner's failure to provide reference that teach or suggest "uploading said digital image to said external network entity or another external network entity subsequent to exchanging **all ordering** information," together with the other elements set forth in the claim

In response to Appellant's arguments, please see response to claim 32, above.

Appellant presents no arguments in support of separate patentability of this claim.

For the above reasons, it is believed that the rejection of claim 41 under 35 U.S.C. § 103(a) for obviousness should be sustained.

**N. Appellant argues, page 27, that the rejection fails to establish a prima facie obviousness of Dependent Claims 20-27, 42-45, and 57-60**

For response to arguments concerning claim 41, please see above.

Appellant presents no arguments in support of separate patentability of other claims.

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For the above reasons, it is believed that the rejection of claims 20-27, 42-45, and 57-60 under 35 U.S.C. § 103(a) for obviousness should be sustained.


### Conclusion

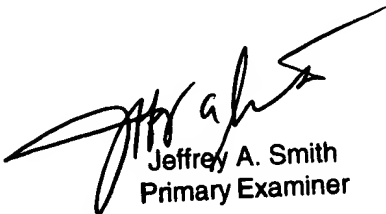
For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,

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May 28, 2004

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